

REMARKS

I. Introduction

In response to the Office Action dated September 16, 2008, claim 8 has been amended. Claims 1-6, and 8-16 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Claim Amendments

Applicants' attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of clarifying the language of the claims, and were not required for patentability or to distinguish the claims over the prior art.

III. Claim Numbering Rejection

On page (2) of the Office Action, claim 8 was rejected for being dependent on canceled claim 7. Applicants have amended claims 8 to depend on claim 1 and submit that the rejection is now moot.

IV. Subject Matter Rejection

On page (3) of the Office Action, claims 1 and 14 were rejected under 35 U.S.C. §101 as providing functional descriptive material (software) in combination with an appropriate computer readable medium that is not capable of producing a tangible result when used in a computer system. The Rejection provides an example that “receive” and “decode” as a function of vertical blanking interval do not produce a tangible result.

Applicants respectfully disagree with and traverse the rejection. Firstly, when rejecting a claim based on 35 U.S.C. §101, it is inappropriate to examine single claim elements within the claims without examining the whole claim and whether the claim itself produces a tangible result (see MPEP 2106). The Examiner has recited “receive” and “decode” and not being statutory. Applicants note that the VBI software is part of a user device and further enables audio and video signals to be displayed on a screen and speaker of the device itself. Thus, rather than not producing a tangible result, the claims explicitly receive broadcast programming and further consist of a screen

and speaker on a device and output decompressed and decoded video programming on the screen and speaker. Such capabilities are clearly within multiple statutory categories and obviously provide a tangible result.

In addition, Applicants note that claim 14 has been rejected. However, claim 14 is dependent on claim 9 which is statutory and has not been rejected on such grounds. Accordingly, Applicants submit that claim 14 depends on a statutory subject matter claim, it is also statutory.

Further, under MPEP 2106(IV)(B), if the invention as set forth in the written description is statutory, but the claims define subject matter that is not, the deficiency can be corrected by an appropriate amendment of the claims. In such a case, Office personnel should reject the claims drawn to nonstatutory subject matter under 35 U.S.C. 101, but identify the features of the invention that would render the claimed subject matter statutory if recited in the claim. Accordingly, should the Patent Office elect to maintain the rejection, Applicants respectfully request that the Office identify the features of the invention that would render the claimed subject matter statutory if recited in the claim.

V. Prior Art Rejections

On page (3) of the Office Action, claims 1-6, 8-11, and 13-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Krisbergh, U.S. Publication No. 20040078824 (Krisbergh). On page (7) of the Office Action, claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Krisbergh and further in view of Russ et al., U.S. Publication No. 20020059642 (Russ). On page (7) of the Office Action, claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Krisbergh and further in view of James, U.S. Publication No. 20020019987. On page (9) of the Office Action, claims 4 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Krisbergh in view of Corvin, U.S. Publication No. 20010029610 (Corvin).

Specifically, independent claims 1 and 9, were rejected as follows:

Regarding claim 1, Krisbergh teaches:

A method for providing broadcast video programming, comprising:

(a) receiving video programming (Fig. 4 - the cable headend equipment; [0029]);

(b) encoding the video programming into a vertical blanking interval and unused Active lines of a television channel (the television transmission may alternatively include one or more streams of data comprising video, audio and other information in a digital and/or analog form. Accordingly, information can be inserted into these streams such as in the VBI as aforesaid or as part of an MPEG transport stream [0027]; Fig. 4/46);

- (c) broadcasting the television channel and encoded video programming into a vertical blanking interval and unused Active lines of a television signal (Fig. 411 2)
- (d) receiving the broadcast encoded video programming in a vertical blanking interval in a user device, wherein the user device comprises (Fig.6/terminal 54):
 - (i) tuning hardware configured to receive normal over-the-air terrestrial broadcasts and to pass the encoded video programming in a vertical blanking interval (Fig. 6/94; television distribution systems and networks include but are not limited to orbiting satellite systems, terrestrial wireless cable systems [0024]);
 - (ii) vertical blanking interval software configured to:
 - (1) receive output from the tuning hardware (Fig.6/94,92); and
 - (2) decode the encoded video programming from the vertical blanking interval (Fig. 6/98);
 - (III) a screen and a speaker (Fig. 6/56; [0050]; and
 - (iv) decompression software configured to:
 - (1) decompress the decoded video programming (processor 96 for decoding and decompressing the coded and/or compressed refresh information [0049]); and
 - (2) output analog audio and video signals from the decoded video programming to enable a user to watch the video programming on the screen and speaker of the user device (television signal is displayed on the display device - Fig. 6/56; the MPEG 2 data stream is composed of video, audio streams [0046]).

Regarding claim 9 see the analysis of claim 1 above where the claim limitation was analyzed.

Applicants traverse the above rejections for one or more of the following reasons:

- (1) Krisbergh, Russ, James, and Corvin do not teach, disclose or suggest a single device that contains numerous required elements including tuning hardware, VBI software, a screen, a speaker, and decompression software; and
- (2) Krisbergh, Russ, James, and Corvin do not teach, disclose or suggest a single device that has both a tuner and conditional access controls.

Independent claims 1 and 9 are generally directed to receiving broadcast video programming in a user device. More specifically, video programming is encoded in the vertical blanking interval (VBI) and unused Active lines of a television channel. The television channel and encoded video programming is broadcast and received in a user device. The user device is configured to receive the normal over-the-air broadcasts (including the VBI) and to pass the encoded video programming (from the VBI). In addition, the user devices have VBI software that receives output from the tuning hardware and decodes the encoded video programming (from the VBI). As set forth in the amended claims, the user device has a screen and speaker. Further, the user device has decompression software that decompresses the decoded video programming and outputs analog audio and video signals to the screen and speaker of the user device itself.

In view of the above, it can be seen that the user device directly receives and tunes the broadcast television channel to receive video programming encoded in the VBI of the broadcast. Such a teaching is distinctly and uniquely nonobvious over the cited prior art.

Krisbergh merely describes an access system and method for providing interactive access to an information source through a television distribution system. The distribution system includes a television distribution network, headend distribution equipment at the headend of the distribution network, and a plurality of terminals at terminal ends of the distribution network. An input device and an upstream transmitter are associated with one of the terminals to input a command for the information source and to transmit the inputted command on an upstream channel of the distribution network, respectively. A headend server, upstream receiver, and data encoder are associated with the headend distribution equipment. The headend server is interfaced to the information source. The upstream receiver is interfaced to the headend server to receive and forward the command to the headend server. The headend server transmits the forwarded command to the information source, and the information source transmits responsive information to the headend server. A data decoder is interfaced to the terminal for decoding the encoded information from the television transmissions. The decoded information is then displayed on a display device. (See Abstract).

As recited above, the present claims explicitly require that the device contains both tuning hardware to receive the broadcast programming, as well as a speaker and screen to display the received information. In rejecting the claims, the Office Action relies on Fig. 6 and paragraph [0050] of Krisbergh to teach the screen and speaker of the device. However, contrary to that asserted, FIG. 6 illustrates set top converters or terminals 54 that feed separately to a display device 56. In this regard, the set top converters are clearly not part of the display device itself. Paragraph [0050] further enforces such an interpretation. The present claims specifically require that the speaker and screen are part of the device itself. Such a single device enables portability for the device to receive and view programming. However, Krisbergh cannot and does not provide such capabilities. Further, since Krisbergh requires a set top box that is separate from the display device, Krisbergh serves to teach away from the present invention.

In addition, Applicants note that dependent claims 8 and 16 provide that the device itself contains subscriber management, conditional access, and encryption functions to control access to the video programming. In rejecting such claim elements, the Office Action relies on James' VBI receiver and namely paragraph [0026]. Paragraph [0026] provides for a VBI transceiver with various level filters, channel scanning capability, message buffer, subscriber communications processing, a

message processor having an encoder and decoder circuitry, PCS interface, etc. However, what is clearly missing is the capability for a single device to have both a tuner, a screen and speaker, as well as conditional access capabilities. In fact, the lack of such a teaching serves to teach away from the presently claimed invention.

As is known in the prior art, conditional access systems commonly have set top boxes. Such set top boxes use conditional access modules (CAMs) that are cards that provide/enable security for the received programming. However, such CAMS explicitly do not have a tuner within the card. Instead, the common and known prior art require the separation of the tuner which exists independently in the set top box itself from the CAM. The CAM and set top box are synchronized together to provide content to be displayed on a television. However, the prior art does not combine the tuner with the conditional access services provided in the CAM. There are multiple reasons for such a lack of a combination – (1) to ensure greater security; (2) to enable low cost card productions that do not include an integrated tuner; (3) if the device had both the tuner and conditional access controls, anyone with a card would have a portable and potentially untrackable access capability to proprietary programming. Such factors teach away from a single card that has both a tuner and conditional access technology as set forth in the present claims.

The teaching away aspect of the claims can be found in various prior art references. For example, US Patent No. 7,463,737 (at FIG. 11 and co. 8, lines 57-col. 9, line 17) clearly illustrates that conditional access modules 1170, 1171 are entirely separate from, and not in the same unit as, the tuners 1020, 1021. Such a reference is merely an example of the many references that require and utilize a tuner in a completely separate module from that of the conditional access programming which exists in a conditional access module (CAM).

In view of the above, it can be seen that while James or Krisbergh may teach the receipt of VBI, they both fail to also teach conditional access technology/controls within the same card. There is a reason for this as is evidenced and as is well known in the prior art. Further, none of the cited references even remotely allude to adding or combining such technology into a single card. The prior art in fact teaches away from such a combination and accordingly, there is not motivation to combine but instead there is a motivation not to combine the references in the manner suggested in the Office Action.

Applicants further submit that while one cannot attack prior art references individually, there must be some motivation to combine the references (even under KSR). Instead of finding a motivation, the prior art clearly teaches away from the present invention.

Moreover, the various elements of Applicants' claimed invention together provide operational advantages over Krisbergh, Russ, James, and Corvin do not. In addition, Applicants' invention solves problems not recognized by Krisbergh, Russ, James, and Corvin do not.

Thus, Applicants submit that independent claims 1 and 9 are allowable over Krisbergh, Russ, James, and Corvin do not. Further, dependent claims 2-6, 8, and 10-16 are submitted to be allowable over Krisbergh, Russ, James, and Corvin do not in the same manner, because they are dependent on independent claims 1 and 9, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 2-6, 8, and 10-16 recite additional novel elements not shown by Krisbergh, Russ, James, and Corvin do not.

VI. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

It is believed that no fees are due at this time. Nonetheless, should any charges be deemed necessary, please charge any such fees, or credit any overpayments, to Deposit Account No. 50-0494 of Gates & Cooper LLP.

Respectfully submitted,

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